



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,698	07/11/2001	Yasuhiro Kawakita	31759-173737	8945

7590 10/11/2005

VENABLE
Post Office Box 34385
Washington, DC 20043-9998

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,698

Applicant(s)

KAWAKITA, YASUHIRO

Examiner

Marissa Thein

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 June 2005 and 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7,9,11,13,14,16,18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-7, 9, 11, 13-14, 16, 18, and 20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's "Amendment" filed on June 22, 2005 and "Supplemental Amendment" filed on July 12, 2005 have been considered.

Applicant cancels claims 22-34 without traverse.

Applicant's response to claims 16, 18, and 20 has not overcome the Examiner's rejection of such claims under 35 USC 101.

Claims 1, 6, 7, 9, 11, 13, and 14 are amended. Claims 3-5, 8, 10, 12, 15, 17, and 19 are canceled. Claims 1-2, 6-7, 9, 11, 13-14, 16, 18, and 20-21 are pending in this application and an action on the merits of these claims follows.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16, 18, and 20-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement

Art Unit: 3627

thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409

Art Unit: 3627

U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the

Art Unit: 3627

patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 16, 18 and 20-21 fail to recite **computer executable** instructions. The claims are directed to a medium. Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3627

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6-7, 9, 11, 13-14, 16, 18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,370,513 ('513) to Kolawa et al. (application is a continuation-in-part of application Ser No. 09/131,141, now U.S. Patent No. 6,263,974 ('974) to Kolawa disclosures of which are incorporated) in view of U.S. Patent No. 6,014,634 to Scroggie et al.

Regarding claims 1, 11 and 18, Kolawa ('974) discloses a sale quantity information coordination service system, device and medium:

- a plurality of process method provider terminals at each of which an information page offering information on, at least a specific process method and process elements are required to implement the specific process is provided (recipe database 16 contains the actual copies of recipes,...the recipe database may act in conduction with an Internet browser to allow the user to access recipes via the World Wide Web, col. 5, lines 44-49);
- a plurality of process element providers terminals at each of which sale quantity information on sale unit and sale prices of the process elements required to implement the specific process is provided (determining the ingredient that need to be purchased once a user selects a suggested menu.....checks the recipe database to determine the necessary food ingredients for the chosen menu as well as the quantity of each ingredient. col. 9, lines 29-33; the purchase product database, each product will have a description and information concerning the

Art Unit: 3627

validity date, the quantity of the product per container, col. 9, lines 51-54; the system can perform price optimization by selecting the product database with the cheapest price for the ingredient, col. 9, lines 59-61);

- a shopper terminal (ordering subsystem); and
- a coordinator terminal comprising a means for sale quantity information request that issues a request for the sale quantity information with respect to process elements included in the information page to at least one process element provider terminal in response to a request from a shopper terminal, a means for compilation that compiles a plurality of sets of sale quantity information provided by the plurality of process element provider terminals in a specific format and a means for providing sale quantity information to the shopper terminal that has requested said sale quantity information (kitchen computer 10 contains a choice subsystem 11, an inventory subsystem 12, an order subsystem 13, an instructions subsystem 14; a remote interaction subsystem 15, a recipe database 16, a purchase product database; col. 3, lines 4-9; coll.9, lines 28-33; col. 10, lines 1-19)
- a means for personal information registration that registers information indicating specific conditions under the process element is to be purchased in correspondence to each shopper (Figure 18; col. 12, lines 16-34); the means for sale quantity information request issues a request to the process element providers for sale quantity information based upon the personal information or

the means for compilation compiles sale quantity information in a specific format based upon the personal information (col. 12, lines 16-34) (Kolowa '513); and

- the personal information includes process element purchase specification information specifying in advance process elements to be purchased or process elements not to be purchased (col. 12, lines 16-34; col. 13, lines 29-35); the means for compilation compiles the sale quantity information so as to specify in advance process elements to be purchased through the means for process element purchase specification based upon the process element purchase specification information or compiles the sale quantity information so as to ensure in advance that the process elements not to be purchased are not specified through the means for process element purchase specification (col. 12, lines 16-34; col. 13, lines 29-35) (Kolowa '513).

Kolawa does not disclose a store within a specific distance from the shopper terminal. Kolawa does disclose the personal information includes at least information specifying one of online purchase or shopper terminal purchase (col. 4, line 66 – col. 5, line 22) as a method for process element purchase ('513, col. 9, lines 29-33; col. 12, lines 19-34); the means for sale quantity information request issues a request for the sale quantity information to process element providers offering process elements online if a shopper specifies that the process element is to be purchased online, and issues a request for the sale quantity information to process element provider terminals ('513, col. 10, lines 16-19; col. 10, lines 34-44). Furthermore, Kolawa does disclose printing out a shopping list to be used on a shopping trip ('974, col. 10, lines 18-19).

Scroggie, on the other hand, teaches the store within a specific distance from the shopper terminal (to select a supermarket in his or her area, col. 6, lines 44-45; the user is required to enter his or her ZIP code, since the system is location dependent, col. 6, line 66 – col. 7, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, device, and medium of Kolawa, to include, the store within a specific distance from the shopper terminal, in order to permit the customer to plan his or her shopping and shopping-related activities more efficiently (Scroggie, col. 2, lines 8-10).

Regarding claims 2, 9, and 16, Kolawa ('974) discloses provide a means for process elements purchase specification to be used to specify a process element to be purchased for each process element (col. 9, lines 28-57; Figures 7a-7b); the shopper terminal is capable of placing an order for a process element by specifying the process element through the means for process element purchase specification and transmitting the complied sale quantity information to the process element provider (the list of needed product is crated and is ...sent to the ordering system which sends it to the store server, col. 10, lines 16-19).

Regarding claims 6, 13, and 20, Kolawa ('513) discloses the personal information includes purchase conditions specification information for specifying purchase conditions for purchasing process elements with priority order ranks attached thereto (col. 12, lines 35-46); provide a specific number of sets of sale quantity information based upon priority order ranks included in the purchase condition specification

information and to indicate that there is a further choice in purchasing process elements apart from the options offered in the sale quantity information provided the means for compilation (col. 12, lines 35-46).

Regarding claims 7, 14, and 21, Kolawa substantially discloses the claimed invention, however, it does not disclose sales promotional information is requested by a shopper terminal that has not registered the personal information. Kolawa does disclose price optimization ('974, col. 9, lines 59-60).

Scroggie, on the other hand, teaches sales promotional information is requested by a shopper terminal that has not registered the personal information (col. 2, lines 28-32; col. 2, lines 39-42; col. 2, line 66 – col. 3, line 9; col. 3, line 66 – col. 4, line 6; Figure 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, device, and medium of Kolawa, to include, sales promotional information is requested by a shopper terminal that has not registered the personal information, in order to permit the customer to plan his or her shopping and shopping-related activities more efficiently (Scroggie, col. 2, lines 8-10).

Response to Arguments

Applicant's arguments with respect to claims 1-2, 6-7, 9, 11, 13-14, 16, 18, and 20-21 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's remark that "Kolowa does not disclose a store within a specific distance from the shopper terminal".

Examiner notes that Scroggie was cited for disclosing a store within a specific distance, as disclosed in the Office Action above.

Applicant's remark that Kolawa "fails to disclose, teach or suggest personal information that includes at least information of online purchase or shopper terminal purchase as the method of process element purchase".

Examiner notes that Kolowa ('513) discloses the personal information that includes at least information of online purchase or shopper terminal purchase as the method of process element purchase. Kolowa discloses a system which comprises a network server for allowing users to enter preferences and retailers to submit to the system information about products and services (col. 6, line 66 – col. 5, line 2). The users and retailers are in communication with the network server through an Internet connection (col. 5, lines 11-13). The user shops on a personal computer by communicating with the recommendation system to decide what item to purchase (col. 5, lines 23-27). Kolowa further discloses a user vector modification which may be done by keeping track of items purchased by the user (col. 12, lines 16-18). The system keeps track of the user's purchase pattern, and creates or updates a preference vector for that user based on such patterns (col. 12, lines 18-21).

Such network communication through an Internet between a retailer and a user; user shopping; keeping track of items purchased by the user; and the user's purchase pattern are considered the personal information that includes at least information of online purchase or shopper terminal purchase as the method of process element purchase.

Applicant's remark that "Kolowa fails to disclose, teach or suggest personal information, in the case of an online purchase including specifying in advance process elements to be purchased or process elements not to be purchased".

Examiner notes that Kolowa ('513) discloses online purchase including specifying in advance process elements to be purchased or process elements not to be purchased. Kolowa discloses a system which comprises a network server for allowing users to enter preferences and retailers to submit to the system information about products and services (col. 6, line 66 – col. 5, line 2). The users and retailers are in communication with the network server through an Internet connection (col. 5, lines 11-13). The user shops on a personal computer by communicating with a recommendation system to decide what item to purchase (col. 5, lines 23-27). The recommendation system may make recommendations about items in the store based on the user's preference vector (col. 12, lines 27-29). Kolowa further discloses a user vector modification which may be done by keeping track of items purchased by the user (col. 12, lines 16-18). The system keeps track of the user's purchase pattern, and creates or updates a preference vector for that user based on such patterns (col. 12, lines 18-21).

Such network communication through an Internet between a retailer and a user; user shopping; the user's purchase pattern; and the recommendation system to make recommendations about items which is based on the user's preference vector are considered online purchase including specifying in advance process elements to be purchased or process elements not to be purchased.

Applicant's remark that "Scroggie's system does not disclose that whether the shopper can make online purchases or not".

Examiner notes that Kolowa was cited for the shopper can make online purchases or not, as discussed above. Scroggie was cited for a store within a specific distance, as disclosed in the Office action above.

Applicant's remark that "neither Kolowa or Scroggie discloses such a system and neither provide motivation to modify Kolowa to achieve the claimed invention".

Examiner notes that the combination of Kolowa and Scroggie discloses the system and the terminal device comprising the personal information, which could determine whether an online purchase or a shopper terminal were to be made. Examiner directs Applicant's attention to the Examiner's response to the Applicant's previous remarks regarding claims 1 and 11.

In response to applicant's remarks that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in Scroggie, col. 2, lines 8-10.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot
October 1, 2005


JAMES MCCLELLAN
PRIMARY EXAMINER